

REMARKS

In view of the foregoing amendments and the following remarks, Applicant respectfully requests reexamination of the present application. Claim 143 has been amended and new Claims 144-168 have been added.

Applicant acknowledges with appreciation the Examiner's indication that Dependent Claims 137 and 138 are allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims.

In the Office Action, the Examiner objected to Claim 143 noting that "particulate product" lacked antecedent basis and that comprises was misspelled. Claim 143 has been amended to correct these issues.

The Examiner has rejected Claims 131-136 and 139-143 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,928,405 to Ranade et al. in view of U.S. Patent No. 4,500,368 to Maher.

U.S. Patent No. 5,928,405 to Ranade et al. ("Ranade") was filed on May 21, 1997 and issued on July 27, 1999. The present application is a divisional application of U.S. Patent Application No. 09/668,805 filed on September 22, 2000, now U.S. Patent No. 6,689,186, which is a divisional application of U.S. Patent Application No. 09/028,277, now U.S. Patent No. 6,277,169, filed on February 24, 1998, which claims priority to U.S. Provisional Patent Application No. 60/039,450 filed February 24, 1997 (*the '450 provisional application*) and to U.S. Provisional Patent Application No. 60/038,258, filed February 24, 1997 (*the '258 provisional application*).

To be considered "prior art" under 35 U.S.C. § 103, the reference must be appropriate prior art under 35 U.S.C. § 102 standards. See MPEP § 2141.01. Due to the fact that: (a) the Ranade reference was filed after and issued after the priority date of the present invention, (b) the claims of the present application are supported by the written description and claims of the '450 and '258 provisional applications, and (c) both the '450 and '258 provisional applications and the present application have at least one inventor in common, Ranade is not a proper prior art reference under 35 U.S.C. § 102. Therefore, Ranade cannot be used to reject the present claims under 35 U.S.C. § 103.

For "a non-provisional utility application to be afforded the priority date of [a] provisional application, the [sic] applications must share at least one common inventor and the written description of the provisional application must adequately support the claims of the non-

provisional application.” New Railhead Mfg. LLC v. Vermeer Mfg. Co., 298 F.3d 1290, 1294 (Fed. Cir. 2002). “In other words, the specification of the provisional must ‘contain a description of the invention and the manner and process of making and using it, in such full, clear, concise and exact terms’ to enable an ordinary skilled artisan to practice the claimed invention in the non-provisional application.” Id. Generally, this description is required to, *inter alia*, show that the applicant “as of the filing date sought, [sic] was in possession of the invention.” Id. at 1295. However, this description requirement “is not subsumed by the ‘possession’ inquiry.” Id. at 1296. “Identity of description is not necessary.” Id. at 1295. See also MPEP § 201.11(I).

Applicant submits that the currently pending claims are adequately supported by the written description and claims of the ‘258 and ‘450 provisional applications, and thus the present application should be afforded the priority date of such provisional applications. Id. For example, supporting disclosure for Independent Claim 131 can be found, *inter alia*, on pp. 37-39 of the ‘258 provisional application, in the claims of the ‘258 provisional application (e.g., Claims 1-2, 4), and on pp. 50-52 of the ‘450 provisional application. For the Examiner’s convenience, attached in Appendix A and B, respectively, is a copy of each of the ‘258 and ‘450 provisional applications. Additionally, the utility and provisional applications have at least one inventor in common (e.g., Kudas and Hampden-Smith). In view of the foregoing, Applicant respectfully submits that the claims of the present application have a priority date of February 24, 1997. Id.

To be considered a prior art reference under 35 U.S.C. § 102(b), the cited reference must have issued or published more than 1 year prior to the effective filing date of the application. See MPEP § 706.02(a). As noted above, the claims of the present application have a priority date of February 24, 1997. Therefore, Ranade must have issued before February 24, 1996 to be a proper prior art reference under 35 U.S.C. § 102(b). As noted above, Ranade issued on July 27, 1999, well after February 24, 1996. Thus, Ranade is not a proper prior art reference under 35 U.S.C. § 102(b).

Ranade is also not a proper prior art reference under 35 U.S.C. § 102(e). To be considered a prior art reference under 35 U.S.C. § 102(e), the invention must, *inter alia*, have been described in a U.S. Patent, filed by another, before the invention of the applicant. 35 U.S.C. § 102(e). For a patent filed under 35 U.S.C. § 111(a) with no claim for the benefit of, or priority to, a prior application, such as Ranade, the prior art date under 35 U.S.C. § 102(e) is

the earliest effective U.S. filing date. See MPEP § 706.02(f). As noted above, the earliest effective U.S. filing date of Ranade is May 21, 1997. As also noted above, the claims of the present application have a priority date of February 24, 1997. Therefore, Ranade is also not a proper prior art reference under 35 U.S.C. § 102(e).

In view of the foregoing, Applicant respectfully submits that Ranade is not a proper prior art reference under 35 U.S.C. § 102, and therefore cannot be combined with U.S. Patent No. 4,500,368 to Maher to reject the pending claims under 35 U.S.C. § 103. Thus, Applicant respectfully submits that the pending claims are allowable and their allowance is respectfully requested. In the event that a telephone conversation would further prosecute and or expedite allowance, the Examiner is invited to contact the undersigned.

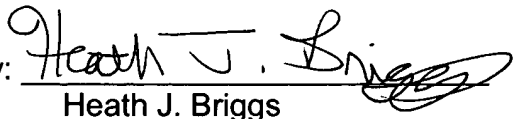
As noted above, Applicant has added new Claims 144-168. Support for such claims may be found in the specification on pages 82, 89, 100 and 102-104, among others. The fee for the additional claims (large entity) is calculated below:

For	Claims Remaining After Amendment	Highest Number Previously Paid For		Extra Claims	Rate		Additional Fee
Total Claims	38	- 20	=	18	x \$50	=	\$900
Independent Claims	1	- 3	=	0	x \$	=	\$0
Multiple Dep. Claim	-	-	\$290			=	\$0
Total Fee						=	\$900

A check in the amount of \$900 for the payment of this fee accompanies this response. Please charge any underpayment and credit any overpayment to Deposit Account No. 50-1419.

Respectfully submitted,

MARSH FISCHMANN & BREYFOGLE LLP

By: 
Heath J. Briggs

Registration No. 54,919
3151 South Vaughn Way, Suite 411
Aurora, Colorado 80014
(303) 338-0997

Date: June 21, 2005